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In re Application of SAIED et al.

Application No.: 09/600,073

PCT No.: PCT/FR99/00040

Int. Filing: 12 January 1999

Priority Date: 12 January 1998

Attorney Docket No.: 1029/00205

For: METHOD FOR EXPLORING AND
DISPLAYING TISSUE OF HUMAN OR
ANIMAL ORIGIN FROM A HIGH
FREQUENCY ULTRASOUND PROBE

DECISION ON
PETITION UNDER
37 CFR 1.47(a)

This is a decision on applicant's petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 05 February 2001. Applicants requested a five month extension of time, which was granted.

BACKGROUND

On 12 January 1999, applicants filed international application No. PCT/FR99/00040 which claimed priority of an earlier U.S. application filed 12 January 1998. A copy of the international application had been communicated earlier to the United States Patent and Trademark Office from the International Bureau on 15 July 1999.

On 19 July 1999, a Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 12 July 2000.

On 11 July 2000, applicants filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee and an English translation of the international application.

On 03 August 2000, the United States Designated/Elected Office (DO/EO/US) mailed a

Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required. The notification set a one month time limit in which to respond.

On 05 February 2001, applicants, in response to 03 August 2000 Notification of Missing Requirements, filed a petition in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor, Michel Puech on the grounds that the non-signing inventor refused to execute the declaration.

DISCUSSION

The petition included the requisite petition fee and a verified statement of someone having first hand knowledge whose name was not identified in the declaration and whose signature was illegible, regarding Mr. Puech's refusal to sign. The signatory of the declaration apparently is an employee of the France Invention Scientific Transfery (FIST), agent for the alleged assignee.

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Items (1), (3), and (4) have been submitted and satisfy the requirements of 37 CFR 1.47(a).

With respect to item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor....

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the

document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

[Emphasis added]

Here, Petitioner submitted a statement of facts under 37 CFR § 1.47(a)(2) executed by person claiming first hand knowledge, however, the person's name is illegible. Paragraphs two (2) and six (6) of the statement states that the *declaration* was sent to Mr. Puech on July 10, 2000 and October 24, 2000. Nor is it clear that the person signing the statement is the one who sent the papers to the inventor. This is insufficient evidence to conclude that applicant/inventor Michel Puech has refused to sign the *application*. What is required is that Mr. Puech be presented with a copy of all of the national stage application papers (oath and declaration, specification, including claims and drawings) for this application as identified above.

Petitioner has not demonstrated that: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 09/600,073 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature, sent to his last known address and (2) Mr. Puech's refusal to sign, either in writing or by telephone, these documents.

In sum, the evidence submitted does not support a finding that the nonsigning inventor refuses to sign the application for the reasons set forth above. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED** without prejudice.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No additional petition fee is required.

A proper response must include either a declaration executed by all inventors or a proper showing that Mr. Puech has been presented with a copy of the application papers for U.S. application 09/600,073 (specification, including claims, drawings, and declaration) and that subsequently, he has refused to execute the application.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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